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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 09/678,295            | 10/02/2000  | Mathias Entenmann    | 35901.3             | 4137             |
| 27683                 | 7590        | 01/26/2009           |                     |                  |
| HAYNES AND BOONE, LLP |             |                      | EXAMINER            |                  |
| IP Section            |             |                      | TRAN, HAI           |                  |
| 2323 Victory Avenue   |             |                      | ART UNIT            | PAPER NUMBER     |
| Suite 700             |             |                      |                     | 3694             |
| Dallas, TX 75219      |             |                      |                     |                  |
|                       |             | MAIL DATE            | DELIVERY MODE       |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MATHIAS ENTENMANN

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Application 09/678,295  
Technology Center 3600

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Mailed: January 26, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on September 22, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

**APPEAL BRIEF, STATUS OF CLAIMS**

A review of the file indicates that the Appeal Brief filed June 20, 2008 does not comply with 37 CFR § 41.37(c) (2007). 37 CFR § 41.37(c)(1)(iii) states:

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

An in-depth review of the Appeal Brief indicates that the “Status of Claims” section is not complete because it only lists the status of the rejected claims. This deficiency was previously noted by the Notification of Non-Compliant Appeal Brief mailed June 16, 2008. Correction is required.

**EXAMINER’S CONSIDERATION OF REPLY BRIEF**

A Reply Brief was filed on August 18, 2008, in response to the Examiner’s Answer mailed July 25, 2008.

37 CFR § 41.43 states:

(a)(1)... the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner’s answer responding to any new issue raised in the reply brief.

The Communication mailed September 11, 2008, was an improper acknowledgment of the Reply Brief as it constitutes a Supplemental Examiner’s Answer as per § 1208, part II of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007).

A Supplemental Examiner's Answer requires a Director or designee's approval.<sup>1</sup>

**CONCLUSION**

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on June 20, 2008 defective;
- 2) to notify appellant to file a paper which corrects the "Status of Claims";
- 3) for consideration of above-noted paper;
- 4) to vacate the Communication mailed September 11, 2008;
- 5) to generate and mail either:
  - a) a revised Communication properly acknowledging the Reply Brief dated August 18, 2008 in accordance with MPEP § 1208, part II.;
  - or
  - b) to issue a Supplemental Examiner's Answer with the required signature, if appropriate; and
- 6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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<sup>1</sup> In Technology Center 3600, only the Director may approve a Supplemental Examiner's Answer.

Haynes and Boone, LLP  
IP Section  
2323 Victory Avenue  
Suite 700  
Dallas, TX 75219